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| 10/541,935 | 07/08/2005 | Werner Reinhart | 1093-133 PCT/US | 8481 |
| 23869 | 7590 | 04/06/2009 | EXAMINER | |
| HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791 | | | | BATTULA, PRADEEP CHOURDARY |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/541,935 | REINHART, WERNER | |
| | Examiner | Art Unit | |
| | PRADEEP C. BATTULA | 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 October 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Lyen (U.S. 6,227,572).

In regards to Claim 1, Lyen discloses security document 10 (Column 2, Lines 33 – 35; Figure 2, Item 10), in particular a value-bearing paper (Column 2, Lines 33 – 35; Figure 2, Item 10), comprising at least one security element 20 (Column 2, Lines 54 – 59; Figure 2, Item 20) provided on a surface of the substrate forming the security document (Column 2, Lines 54 – 59 teaches that 20 is embossed on the banknote), wherein to form the security element at least one surface region of the security document is of a configuration and size specific to the respective security document in such a way and is spatially displaced, for example recessed or raised, at least relative to the surface of the substrate (Column 2, Lines 54 – 59 states that 20 is embossed on the bank note and therefore there is a raised configuration on one side and a recessed configuration on one side) which is adjacent or surrounding the surface region, and/or is of such a different roughness, hardness, elasticity, slipperiness, thermal conductivity and/or stickiness, that the configuration and size of the surface region can be established as a consequence of the differing surface nature thereof by means of the

human sense of touch (Column 2, Lines 60 – 64; Column 3, Lines 3 – 14, 20 – 30; Figure 3, item 40; teaches that a UV overprint varnish is placed with the raised surfaces and in at least the area comprising the cavities that are formed and it is known that varnishes are smooth surfaces; One running their fingers on the surface with 40 will feel the recesses and smooth surface of the varnish along with the surface of the substrate), and wherein the at least one surface region is formed by a film portion 40 which is of a corresponding configuration and which is applied to the substrate and which comprises a material different from the substrate and which has openings through which the surface of the substrate can be felt (Column 2, Lines 60 – 64; Column 3, Lines 3 – 14, 20 – 30; Figure 3, item 40; Figure 2, Item 20 shows gaps in between the embossments and therefore two areas where the film exists and in between the two areas the substrate exists without coating 40).

In regards to Claim 2, Lyen further discloses wherein the substrate and the film portion are formed by different kinds of film (Column 1, Lines 38 – 41 teaches the sheet material 30 for the banknote is paper; Column 3, Lines 20 - 30 teaches that the material of the film portion 40 is of a varnish), which markedly differ in properties which can be detected by means of the human sense of touch (The varnish will be feel different than paper when one runs fingers upon that portion. Column 3, Lines 40 – 48 teaches of the size of the coating and is absorbed by the substrate but since there is a coating and substrate area surrounded by only substrate there will be a tactile difference which is at least smoother in the area of the group of embossments 20).

In regards to Claim 6, Lyen further discloses wherein the security document has a plurality of surface regions which have different surface properties in relation to the substrate surface (Figure 2, Item 20 shows the embossments exist in more than one area which is more than one surface regions and since they are raised or recessed depending on the surface used there is a different surface property in relation to the substrate surface).

In regards to Claim 13, Lyen further discloses wherein the edge of the at least one surface region is in the configuration of a simple geometrical figure (Figure 2, Item 50; the surface region can be defined as the general area in which the raised surfaces exist and that area as seen in Figure 2, Item 50 defines a general rectangle. If Applicant defines the surface region as just one of the raised portions then a circle still fits the limitation of a simple geometrical configuration).

In regards to Claim 15, Lyen further discloses wherein at least in the at least one surface region the substrate is deformed by embossing to provide forwardly curved portions on a surface of the substrate and corresponding recesses on the other surface of the substrate (Column 2, Lines 54 – 59 states that 20 is embossed on the bank note and therefore there is a raised configuration on one side and a recessed configuration on one side; Figure 3).

In regards to Claim 17, Lyen further discloses wherein it is provided with at least one further security element which can be checked optically or by machine (Column 4, Lines 12 – 18 teaches that more than one of the embossment areas are used in case of

damage therefore it is a further security element, even though it was a duplicate. The embossments can be seen and therefore checked optically).

2. Claims 1 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrmann et al. (Hermann; U.S. Pub. 2002/00303360).

In regards to Claim 1, Hermann discloses a security document 1 (Paragraph 0030, Lines 1 – 2; Figure 1, Item 1), in particular a value-bearing paper (Paragraph 0031, Lines 1 – 2; Figure 1, Item 2), comprising at least one security element 3 or 8,13 provided on a surface of the substrate forming the security document (Paragraph 0031, Lines 1 - 8; Figure 1, Item 3 or Paragraph 0034, Lines 1 – 2; Paragraph 0037 teaches that various foils and materials can be used to create the optical effects of Item 13; Figure 1, Items 8, 13), wherein to form the security element at least one surface region (Figure 1, Item 3 and one of the four legs) of the security document is of a configuration and size specific to the respective security document in such a way and is spatially displaced, for example recessed or raised, at least relative to the surface of the substrate which is adjacent or surrounding the surface region (Paragraph 0031, Lines 7 – 8; Figure 1, Item 3; teaches that it is an embossed item which is attached to the substrate or Paragraph 0034, Lines 1 – 2 teaches that the portion is recessed), and/or is of such a different roughness, hardness, elasticity, slipperiness, thermal conductivity and/or stickiness, that the configuration and size of the surface region can be established as a consequence of the differing surface nature thereof by means of the human sense of touch, and wherein the at least one surface region is formed by a film portion (Paragraph 0031, Lines 7 – 8 teach it is a continuous element on the substrate

and therefore it can be a film or Paragraph 0034, Lines 1 - 2 teaches that the portion is recessed and one running there finger across the portion can feel the dip and raising on the substrate and Paragraph 0037 teaches of the foil and element 13 wherein more than one element 13 can be provided) which is of a corresponding configuration and which is applied to the substrate and which comprises a material different from the substrate and which has openings through which the surface of the substrate can be felt (Figure 1, Item 3 shows 4 portions with substrate portions in between; furthermore the substrate is paper and a reflective material will not be made of paper or Paragraph 0037 teaches that the foil capable of various materials can also be used to create the security element of 13 which a foil will different in feeling from a substrate of paper and running ones finger between portions 13 will have them feel the substrate; furthermore paragraph 0037 teaches that various coatings can be used and they will also have a different feeling to paper substrates).

In regards to Claim 2, Hermann further discloses wherein the substrate (Paragraph 0031, Lines 1 – 2; teaches substrate is paper) and the film portion are formed by different kinds of film (Paragraph 0032, Lines 7 – 8 teaches the film is reflective and embossed), which markedly differ in properties which can be detected by means of the human sense of touch (A reflective film itself will be smoother and the embossments will be raised and have a bumpier surface than the substrate).

In regards to Claim 3, Hermann further discloses wherein the substrate and the film portion are formed by papers with respective markedly different surface properties which can be determined by means of the human sense of touch (Paragraph 0037

teaches that the foil for 13 can be of various materials and that on the surface of the foil there is an optical effect which can be made in various ways. Furthermore the material used for the foil can be coated and that coating will also have a different feel from the substrate to which the foil is attached).

In regards to Claim 4, Hermann further discloses wherein the different surface properties of the papers are formed by corresponding printing (Paragraph 0038 teaches of a printing 14; Figure 1, Item 14 shows the printing existing in the recessed area, element 13 and on the plane surface 6 of the substrate).

In regards to Claim 5, Hermann further discloses wherein the different surface properties of the papers are produced by region-wise mechanical processing of the papers, in particular by roughening, embossing and/or glazing (Paragraph 0037 teaches of optical effects for element 13 and it is well known optical effects are done by methods such as embossing).

In regards to Claim 6, Hermann further discloses wherein the security document has a plurality of surface regions (each portion of the "X" of item 3 extending from the center can be considered a surface region or the recessed portions having element 13) which have different surface properties in relation to the substrate surface (Paragraph 0031, Lines 1 – 2; teaches substrate is paper; Paragraph 0032, Lines 7 – 8 teaches the film is reflective and embossed - A reflective film itself will be smoother and the embossments will be raised and have a bumpier surface than the substrate or Paragraph 0037 teaches of different materials for the foil and different coatings in order to create optical effects where some optical effects have embossments - each optical

effect created with the different materials and coatings will have a different feel to the substrate surface).

In regards to Claim 7, Hermann further discloses wherein the surface regions involve a differing configuration, size and/or surface nature (Paragraph 0037 teaches that element 13 can have various materials and coating and since more than one can be on the value document there can be different configurations to create different optical effects and elements 13).

In regards to Claim 8, Hermann further discloses wherein the film is three-dimensionally embossed at least in region-wise manner for producing a particular structure (Paragraph 0032, Lines 7 – 8 teaches the film is reflective and embossed).

In regards to Claim 9, Hermann further discloses wherein the film is provided in region-wise manner with a coating, for example printing thereon, which produces a special surface nature which can be felt (Paragraph 0038 teaches of a printing 14; Figure 1, Item 14 shows the printing existing in the recessed area, element 13 and on the plane surface 6 of the substrate; Furthermore printing on a substrate can be felt by the human sense of touch).

In regards to Claim 13 and 14, Hermann further discloses wherein the edge of the at least one surface region is in the configuration of a simple geometrical figure and wherein the at least one surface region is in the form of an elongate rectangle, in particular of a strip shape (Paragraph 0032, Lines 5 – 7 teach that there is just a general security element 3 Inherently it can be of any geometric continuous shape considering it is in the form of a continuous shape of a letter).

In regards to Claim 16, Hermann further discloses wherein the substrate has at least one surface region of a surface nature which differs in relation to the surrounding surface of the substrate (Paragraph 0032, Lines 1 – 5; Figure 2, Item 5 teaches that a foil is present on the substrate and which would be a different surface nature), and at least one opening 4 (Paragraph 0031, Lines 1 – 2 teach of the substrate; Paragraph 0032, Lines 1 – 3 teaches of the window opening; Figure 2, Items 2, 4).

In regards to Claim 17, Hermann further discloses wherein it is provided with at least one further security element 13 which can be checked optically or by machine Paragraph 0037 teaches that various foils and materials can be used to create the optical effects of Item 13; Figure 1, Items 8, 13; optical effects are checked optically).

In regards to Claim 18, Hermann further discloses wherein the security element which can be checked optically or by machine overlaps at least region-wise with the at least one surface region of the surface nature which differs in relation to the surrounding surface of the substrate and/or the opening (Figure 13 overlaps the depressed region 8).

In regards to Claim 19, Hermann further discloses wherein the security element which can be optically checked is formed by a pattern comprising diffraction structures, for example a hologram, and/or a region-wise metallization (Paragraph 0037 teaches of element 13 being of an optical effect and such are created as holograms or by diffraction structures).

In regards to Claim 10, Hermann discloses a security document, in particular a value-bearing paper (Paragraph 0030, Lines 1 – 5; Figure 1), comprising at least one

window-like opening 4 in the substrate 2 of the security document (Paragraph 0031, Lines 1 – 2 teach of the substrate; Paragraph 0032, Lines 1 – 3 teaches of the window opening; Figure 2, Items 2, 4), said opening forming at least part of a security element (Paragraph 0039), wherein the window-like opening is of a configuration and size specific to the respective security document and is so adapted that the configuration and size of the opening can be determined by means of the human sense of touch (Paragraph 0036 teaches that a diffraction structure can be used to cover the window 4 and therefore must be visible; considering the element must be visible, the opening is inherently at least minimally discernible from the substrate with the sense of touch), and wherein the opening is covered by a film fixed 5 on a surface 6 of the substrate (Paragraph 0032, Lines 1 – 5; Figure 2, Items 5, 6), wherein the film has a surface nature which is markedly different from the surface nature of the substrate in a manner which can be determined by means of the human sense of touch (Paragraph 0041 teaches of a primer layer 17 placed on the film 5 to allow for the film to receive printing and primer is taught to be significantly different from paper in Paragraph 0052 and therefore can at least be felt by the human sense of touch; Figure 3, Item 17), insofar as it is provided that a) the film projects beyond the opening of the substrate and in its projecting region is provided with at least one aperture through which the surface of the substrate can be felt and/or b) the film is three-dimensionally embossed at least region-wise to produce a particular structure, and/or c) the film is provided in a region-wise manner with a coating 14, for example printing thereon, which produces a special surface nature which can be felt (Paragraph 0041, Paragraph 0038, Lines 1 – 5 teaches

of an overprinting on the foil 5 and it is well known that indicia on a sheet can be felt by running one's finger across the sheet), and/or d) the film is provided at least in its region covering the opening with a perforation in the form of a pattern which can be easily felt.

In regards to Claim 11, Hermann further discloses wherein the security document has a plurality of window-like openings which can be felt in respect of size and configuration by means of the human sense of touch (Paragraph 0032, Lines 1 – 2 teaches that at least one window exists; Paragraph 0039, Lines 8 – 15 teaches of multiple windows).

In regards to Claim 12, Hermann further discloses wherein the openings are of differing configuration and/or size and/or are covered with a film having different properties (Paragraph 0036, Lines 7 – 15 teach of the various different elements that one foil element can contain and therefore different foils can have different arrangements of these elements).

Response to Arguments

Applicant's arguments with respect to claims 1 – 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
March 28, 2009

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725